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## REMARKS

### Claim Objections

Claim 10 was objected to because of an informality in line 2 concerning the term "securing." Appropriate correction has been made by the amendment presented above.

### Anticipation Rejections

Claims 1-3, 10 and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,014,833 ("Benavidez") or U.S. Patent No. 6,269,587 ("Wallace").

Claims 4, 7, 9, 11-14, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Benavidez.

Claims 18-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wallace.

The anticipation rejections are respectfully traversed because the cited references fail to describe "each and every element as set forth in the claim," as is required for a proper anticipation rejection. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 (as amended) and the rejected claims that depend therefrom (i.e., claims 2-4, 7, 9-11, and 17-20) all include the element of "a buoyant board-like support member having at least a pair of opposing gripping apertures or indentions provided *therein*, the gripping apertures or indentions each being *disposed adjacent respective opposing edges of the support member* and each being *elongated along an axis that is substantially parallel to the respective opposing edges to facilitate insertion of the fingers of both hands of a user in the respective pair of gripping apertures or indentions simultaneously*, thereby providing for balanced hand gripping of the support member by a user" (emphasis added). The Examiner points to the drink accessory inserts 68 and fishing pole inserts 69 of Benavidez, and the fishing rod handle insertion cavities 36, 40 of Wallace, as satisfying this claimed element. There is simply no teaching whatsoever in Benavidez or Wallace that these

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components describe the recited "gripping apertures or indentions," particularly in view of the "elongated along an axis ..." character of the claims. The very names that Benavidez and Wallace chose to give the referenced components (e.g., "drink accessory inserts" and "fishing pole inserts") defy such description. Furthermore, the italicized language of the claim element above (i.e., "elongated and oriented") particularly excludes the round inserts of Benavidez and Wallace.

Nor does the "handle" shown in FIG. 1 of Wallace anticipate the recited "gripping apertures or indentions" since that handle is not "provided therein" (instead, it is attached) and there is only one such handle. Assuming for the sake of argument that the handle of Wallace was equivalent to the claimed apertures/indentions (it is not), the claimed requirement of a "pair" of apertures/indentions is not a mere duplication of parts that lacks patentable significance. Thus, e.g., the claimed pair of apertures/indentions "may serve as a surfacing aid for one who has stepped across a drop-off or into a hole while fishing," among other things. *Applicants' Specification*, page 6, lines 9-11. This is a completely new and unexpected utility (i.e., surfacing through balanced hand gripping) compared to that exhibited by the single handle of Wallace: guiding or steering the apparatus. One trying to use the single handle of Wallace as a surfacing aid, e.g., would upset the apparatus of Wallace because there is no opposing handle thereon to balance a user's single-handed gripping force (i.e., the apparatus of Wallace would flip over). Reconsideration and withdrawal of the above-noted rejections are therefore respectfully requested.

Claim 12 (as amended) and the rejected claim that depends therefrom (i.e., claim 14; claim 13 has been canceled) all include the element of "a first bait container secured to the support member for storing bait, the first bait container being equipped with one or more apertures for passage of ambient water therethrough." The Examiner points to the tackle storage container 40 of Benavidez as satisfying the "first bait container" requirement of the noted claim element, and the drink accessory inserts 68 of Benavidez as satisfying the requirement of "apertures for passage of ambient water" through the first bait container. The Examiner has apparently misconstrued Benavidez. The drink accessory inserts 68 of Benavidez clearly do not serve as apertures in the tackle storage container 40 of Benavidez. Inserts 68 are not even associated with the container 40, nor are the inserts 40

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described as permitting passage of ambient water therethrough. The tackle storage container 40 of Benavidez is said to include "numerous bins and storage locations for storing fishing hooks, lures, and tackle including tools ..." (col.4, lines 8-11), which use would undoubtedly be frustrated by passages permitting ambient water to flow therethrough.

Additionally, claim 12 (as amended) and the rejected claim that depends therefrom (i.e., claim 14) all further include the element of "a first upright tubular gear container *secured to and extending substantially above the support member* for supporting elongated fishing gear in a *substantially vertical position above the support member*" (emphasis added). The Examiner points to the fishing pole inserts 69 of Benavidez as satisfying this element. The inserts 69 are cavities formed through the top surface 14 of the body member 10 of Benavidez and do not extend above the body member 10. Even assuming for the sake of argument that the live bait bucket 21 of Benavidez could be construed as an "upright tubular gear container" (it could not), the bucket clearly does not extend "substantially above the support member for supporting elongated fishing gear in a substantially vertical position above the support member" as is required by claim 12. Reconsideration and withdrawal of the rejections concerning claims 12-14 are also respectfully requested.

#### Obviousness Rejections

Claim 5 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez or Wallace as applied to claim 1 above, and further in view of U.S. Patent No. 4,918,853 ("Bascom").

Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez as applied to claim 14 above, and further in view of U.S. Patent No. 5,163,694 ("Reicheck").

Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez as applied to claim 1 above, and further in view of U.S. Patent No. 5,394,639 ("Tentler").

Claims 21-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez as applied to claim 20 above, and further in view of U.S. Patent No. 4,794,723 ("Arnold").

The obviousness rejections of claims 5, 15, 16, and 21-23 are each predicated on the anticipation rejections of either claim 1 or claim 12, from which these claims depend. Since those

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anticipation rejections are traversed, and claims 1 and 12 are submitted to be patentable as explained above, claims 5, 15, 16, and 21-23 are also submitted to be patentable. Reconsideration and withdrawal of the rejections concerning these claims are also respectfully requested.

Claims 24-26 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez in view of Wallace. Claim 27 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Benavidez as modified by Wallace as applied to claim 25 above, and further in view of U.S. Patent No. 5,802,760 ("Campbell"). These rejections are respectfully traversed because the Examiner has failed to present a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143. At least one of these criteria – and probably all three – is lacking, as explained below.

Claims 24 and 28 as amended both recite the requirements of: "a fish container secured to the support member adjacent one end thereof for holding live fish;" and a "bait container secured to the support member adjacent another end thereof opposite the one end for holding live bait." Both the fish container and bait container are characterized as "being equipped with one or more apertures for passage of ambient water therethrough." The Examiner points to the live bait bucket 21 of Benavidez as satisfying the noted fish container limitation of claims 24, 28, and points to the tackle storage container 40 of Benavidez as satisfying the noted bait container limitation of claims 24, 28. As mentioned previously, the Examiner has misconstrued the drink accessory inserts 68 and fishing pole inserts 69 of Benavidez as being apertures in the tackle storage container 40 that permit ambient water to pass through that container. Thus, even if the container 40 of Benavidez were to serve as a bait container (it is literally described as a "bait bucket"), it would not include the claimed requirement of "one or more apertures for passage of ambient water therethrough." It is further noted that Benavidez describes a fish stringer 60 which includes a retractable stringer line 61 "to attach the

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[caught] fish to the device providing a convenient location for storing the fish during the fishing outing ... and assuring that the fish remain fresh throughout the fishing day." *Benavidez*, col. 4, lines 31-37.

The Examiner points to the sealable mesh bag 18 (with fish holding portion 58) of Wallace as satisfying the bait container limitation of claims 24, 28. It is unlikely that the bag 18 of Wallace is suitable for holding bait, as demonstrated by the large fish depicted within the bag 18 and the relatively large mesh openings in the bag 18 of FIG. 1 of Wallace. Additionally, Wallace fails to describe any other means for retaining (caught) fish, but Wallace does describe a tackle box compartment 30. It has therefore been assumed that the Examiner meant to apply the mesh bag 18 of Wallace as teaching the fish container limitation of claims 24, 28, and apply the live bait bucket 21 of *Benavidez* as teaching the bait container limitation of claims 24, 28, and that the Examiner has concluded that it would have been obvious to combine these (presumed) teachings.

Section 103(a) of the patent statute (35 U.S.C.) states that "[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." In making the assessment of differences, Section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Env'tl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction prevents evaluation of the invention on a piecemeal basis. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result — often the very definition of invention.

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Section 103 precludes this hindsight-based discounting of the value of new combinations by requiring assessment of the invention as a whole. The Federal Circuit has provided further assurance of the "as a whole" assessment of the invention under Section 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, a patent examiner or court must show some suggestion or motivation, prior to the applicant's invention, to support a rejection based upon a new combination of prior art references. *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998). The requirement of a suggestion to combine is the first of the three above-noted criteria of a *prima facie* case of obviousness.

More particularly, given the "subtle but powerful attraction of a hindsight-based obviousness analysis," the law requires a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, to properly support a proffered combination of references, a patent examiner "must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them" in the proffered manner. *In re Rouffet*, 149 F.3d at 1359. Close adherence to this rigid methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Dembiczak*, 175 F.3d at 999 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). Additionally, it is never appropriate for an Examiner to rely solely on "common knowledge in the art" without evidentiary support in the record as the principal evidence upon which a rejection was based. *MPEP* § 2144.03.

As explained above, the Examiner has combined selective portions of (a) one fishing device having a live fish mesh bag and a tackle storage compartment (i.e., Wallace) with (b) another fishing device having a live fish stringer, a live bait bucket, and a tackle storage container (i.e., Benavidez), to attempt to reproduce the inventions of claims 24 and 28. No motivation has been identified for

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these selective combinations. The examiner is apparently relying on the fact that Benavidez and Wallace both describe fishing apparatuses as sufficient motivation to selectively combine portions of the two references. Such a generalized conclusion simply fails to satisfy the level of specificity that is required by the law. *Dembiczak*, 175 F.3d at 999.

Nor has there been any explanation of how the proffered combinations of Benavidez with Wallace, etc. could reasonably be expected to succeed (the second criterion of a *prima facie* case). By way of example, since the top body surfaces 14 and 22 of Benavidez and Wallace, respectively, are already well utilized, it is far from clear that such surfaces could support additional containers.

Rather than suggesting its combination with Wallace, Benavidez actually teaches away from the proffered combination since Benavidez already includes means for achieving live bait storage (bait bucket 21), tackle storage (tackle storage container 40), and live fish storage (live fish stringer 60). The addition of a live fish bag (like mesh bag 18 of Wallace) to Benavidez would be redundant, and would likely compromise the other utilities (e.g., drink accessory inserts, fishing pole inserts) of Benavidez. Stated another way, one skilled in the art would likely not be motivated to add a live fish bag to Benavidez, because Benavidez already provides a live fish stringer (see the above-noted passage in Benavidez, col. 4, lines 31-37). The mere fact that references can be combined or modified (e.g., to produce two means for retaining live fish) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *MPEP* § 2143.01.

Furthermore, with respect to claim 24 as amended, the proffered combination of references fails to produce a fishing apparatus having a live fish container that is adjacent one end of a support member and a live bait container that is adjacent another end of the support member opposite the first end, with a second bait container therebetween, as is presently claimed. Both of the near-end areas of Benavidez are occupied by things other than live fish/bait containers, so the modification of Benavidez in this manner would radically change the utility of Benavidez. As a result, the third criterion (producing all claimed elements) of the *prima facie* case is clearly lacking. Additionally, this is consistent with an absence of the required suggestion to combine the applied references (i.e.,

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another example of teaching away by Benavidez because existing utilities would be compromised).

Claim 28 has been further amended by that claim's recital of a "pair of opposing gripping apertures or indentions" in a manner consistent with claim 1. Claim 28 is therefore submitted to be further patentably distinguished for the reasons presented above in regard to claim 1.

In consideration of the above discussion concerning claims 24-28, there is a clear failure of the first criterion of a *prima facie* case of obviousness, and failures of the second and third criteria as well. Accordingly, reconsideration of claims 24-28, and withdrawal of the rejections thereof, are respectfully requested.

#### Conclusion

This response is believed to place all pending claims in condition for allowance, and such action is earnestly solicited. In the event that the Examiner is not fully persuaded by this response, the Examiner is respectfully requested to contact the undersigned attorney for the Applicants by telephone to discuss this response.

In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/CORA/0002 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



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